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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/705,559	11/02/2000	Joseph A. McCluskey	31083.048001	8707
34018	7590	06/01/2004	EXAMINER	
GREENBERG TRAURIG, LLP 77 WEST WACKER DRIVE SUITE 2500 CHICAGO, IL 60601-1732			KYLE, CHARLES R	
			ART UNIT	PAPER NUMBER
			3624	

DATE MAILED: 06/01/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/705,559

Applicant(s)

MCCLUSKEY ET AL.

Examiner

Charles R Kyle

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 04 March 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 6 recites the limitation "the electronic request for quotation" in line 5. There is insufficient antecedent basis for this limitation in the claim.

### ***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

**Claims 1-3, 6-7 and 9-13** are rejected under 35 U.S.C. § 101 because, the claimed invention is directed to a non-statutory subject matter. Specifically the method claim as presented does not claim a technological basis in the pre-amble and the body of the claim. Without a claimed basis, the claim may be interpreted in an alternative as involving no more than a manipulation of an abstract idea and therefore non-statutory under 35 U.S.C. 101. In contrast, a method claim that includes in the body of the claim at least one structural / functional interrelationship which can only be computer implemented is considered to have a technological basis [See Ex parte Bowman, 61 USPQ2d 1669, 1671 (Bd. Pat. App. & Inter. 2001) - used only for content and reasoning since not precedential].

In order to over come the 101 rejection above, the following preamble is suggested:

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“A computer implemented method for ---”, or something similar. Also, in the body of the claim include at least one structural / functional interrelationship which can only be computer implemented.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**Claims 1 and 6-16** are rejected under 35 U.S.C. 103(a) as being unpatentable over US 2001/0044758 *Talib et al* in view of *Liddy*, already of record.

**As to Claim 1**, *Talib* discloses the invention substantially as claimed, including in a method for providing a customer with information regarding a product (Summary of the Invention), the steps of:

Receiving an electronic request for information for the product (Para. 19, lines 4-5);

Searching a database to determine if the database contains information for the product (Para 19, lines 5-10);

If the database contains information for the product, sending an electronic message to the customer containing selected information for the database corresponding to the product (Para. 19, lines 10-15).

If information is not found for the product, performing a subsequent search to gather information for the product (Figs. 10 and 11; Paras.120-146), sending the gathered information

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in an electronic message to the customer (Para. 19) and adding gathered information to the database (Para. 6).

*Talib* does not specifically disclose an automatic request to a sourcing agent to perform a search outside the database to gather information unavailable in the database. *Liddy* discloses this limitation at Abstract, underlined text and Col. 9, line 49 to Col. 11, line 57. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have broadened the product search disclosed by *Talib* by searching additional databases disclosed by *Liddy* because this would have given a greater search area and increased the likelihood that the customer would receive relevant information from subsequent searches. See *Liddy* at Col. 3, lines 7-12 and 36-39 for benefits providing motivation to combine the references.

*Liddy* also discloses adding gathered information to the database at Col. 11, lines 41-50.

**Concerning Claim 6,** *Talib* discloses the invention substantially as claimed. See the discussion of Claim 1. *Liddy* further discloses comparing the electronic request against a set of predetermined rules to determine a sourcing agent to which the electronic request is to be routed (Col. 9, lines 13-48) and automatically routing the electronic request to the sourcing agent determined to be appropriate by the step of comparing the sourcing agent performing a search to find a source for the information specified in the request (Col. 9, lines 49-65). It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify *Talib* with the agent administration functionality disclosed by *Liddy* because this would make most effective use of agent capabilities.

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**With respect to Claim 7,** *Talib* discloses predetermined product descriptors for comparing words in an electronic request at paras. 28 and 82-85.

**Concerning Claim 8,** Official Notice is taken that the use of e-mail to provide information to users regarding searched for information was old and well known at the time of the invention. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify *Talib* to use e-mail to answer requests because this would be familiar and inexpensive to users.

**Concerning Claim 9,** see the discussion of Claims 1 and 6. Claim 9 recites a computer readable medium to perform the method; *Talib* discloses such a computer readable medium for method execution at para. 164.

**As to Claim 10,** *Talib* discloses sending the source for a product specified in a request to the request originator at Figs. 7-9, at least.

**As to Claim 11,** *Talib* discloses the invention substantially as claimed, including in a method for providing a customer with information regarding a product (Summary of the Invention), the steps of:

Receiving an electronic request for information for the product (Para. 19, lines 4-5);

Searching an electronic (Fig. 9; para. 113) database to determine if the database contains information for the product (Para 19, lines 5-10);

If the electronic (Fig. 9; para. 113) database contains information for the product, sending an electronic message to the customer containing selected information for the database corresponding to the product (Para. 19, lines 10-15).

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If information is not found for the product in the electronic (Fig. 9; para. 113) database, performing a subsequent search to gather information for the product (Figs. 10 and 11; Paras.120-146), sending the gathered information in an electronic message to the customer (Para. 19) and adding gathered information (Para. 6) to the electronic (Fig. 9; para. 113) database.

Applicant has added the limitation that a search outside the electronic database is performed. *Liddy* discloses the feature of extended search to obtain information on the product at Abstract, underlined text and Col. 9, line 49 to Col. 11, line 57. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have broadened the product search disclosed by *Talib* by searching additional databases disclosed by *Liddy* because this would have given a greater search area and increased the likelihood that the customer would receive relevant information from subsequent searches. See *Liddy* at Col. 3, lines 7-12 and 36-39 for benefits providing motivation to combine the references.

**With respect to Claim 12**, see the discussion of Claim 11, and *Talib* further discloses an option to authorize a further search at paras. 28, 47 and 99 at least.

**With respect to Claim 13**, see the discussions set forth above.

**As to Claim 14**, *Talib* does not specifically disclose third party maintenance of an electronic catalog and search component on a web server, although *Talib* does disclose that a web page is used for searching of product databases at paras. 109-112.

Official Notice is taken that service by third party contractors is old and well known in the business arts. For example, contracting out of accounting and database management allows an organization to concentrate on its core mission.

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It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the teachings of *Talib* to include third party support of catalog services because this would have relieved the seller of catalog maintenance and search support functions and freed it to concentrate on those things it did best, making and selling products.

**Concerning Claim 15**, *Talib* does not specifically disclose a single portal for all catalog and broadened search functions.

Official Notice is taken that a unified entry point for web related functions is old and well known in web technologies. For example, provision of a single, centralized portal for database search makes search simpler for a user by allowing search of multiple databases at once.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the teachings of *Talib* to include a single portal for catalog and extended search because this would provide convenience and speed of search to the customer.

**Concerning Claim 16**, see the discussion of Claim 15 and note the greater efficiency of a single web server as compared to having components spread among many locations.

**Claims 2-5** are rejected under 35 U.S.C. 103(a) as being unpatentable over US 2001/0044758 *Talib et al* in view of *Liddy* and further in view of US 5,842,178 *Giovanolli*.

**Concerning Claim 2**, see the discussion of Claim 1. *Talib* does not specifically disclose that a forwarded request is a request for quotation (RFQ). *Giovanolli* discloses forwarding RFQs to potential sellers at Col. 2, line 56 to Col. 3, line 8. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the product



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information search of *Talib* to forward the RFQs disclosed by *Giovanolli* because this would have provided a breadth of pricing information as described by *Giovanolli* at Col. 2, lines 12-35 and set forth below:

*In all of the above cases the vendors responding to the buyers request regarding a particular good or service are either the service provider or a vendor with whom the service provider is involved in another business relationship such as advertisers in a common publication or affiliated insurance carriers. These select vendors provide the product and pricing information supplied by the system to buyers. These systems have no capacity to offer an unlimited number of goods and services from any number of vendors who wish to become members of the system. This would require an unrealistically large central database containing information about products, services and vendors. Each vendor would be required to provide detailed information to the central database about its product lines and would be required to update them daily. Accordingly, existing systems are very specialized electronic buying services with a limited selection of goods, services, and vendors. In addition, buyers wishing to sell surplus inventory from time to time cannot use these systems for that purpose.*

*The present invention is analogous to a cross between telephone and broadcasting technologies. It is this difference which creates the opportunity for buyers to relate to vendors without a rigid structure operating through a centralized computer database as required by existing methods.*

**With respect to Claim 3,** *Giovanolli* further discloses preparation of an RFQ at a prompt by a customer at Col. 7, line 67 to Col. 8, line 2. It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide such a prompt to indicate to the customer the option of preparing an RFQ.

**As to Claim 4,** *Talib* discloses the use of the Internet for information requests at Paras. 71-78, at least.

**Concerning Claim 5,** *Giovanolli* discloses forwarding electronic requests as e-mails at Col. 4, line 4-52. This would have been an obvious modification of the invention of *Talib* because it would have provided a familiar and inexpensive way to convey requests.

*Response to Arguments*

Applicants' arguments filed March 45, 2004 have been fully considered but they are not persuasive.

Applicants have essentially amended the Claims to additionally recite that automatic requests to search outside databases. These limitations have been addressed in the rejections set forth above.

More generally, Applicants seem to view searching outside a single database if sought information is not immediately available in that database as patentable. As already discussed in the prior office action, this is the traditional function of a purchasing agent. Applicants' claims are met by simple business practice of checking company inventory databases for product, and if the product is not present in company inventory, tasking a purchasing agent with finding a seller to provide the product. The use of the word automatically lends little patentable weight because no detail is given on how function is performed automatically. A broad reading of this limitation would be the "automatic" search performed by a purchasing agent when he/she notes that a product is out of stock.

Rejection of the Claims is maintained.

***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Charles R. Kyle whose telephone number is (703) 305-4458. The examiner can normally be reached on M-F 6:00-2:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent A Millin can be reached on (703) 308-1065. The fax phone number for the organization where this application or proceeding is assigned is (703) 305-7687.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Examiner Charles Kyle



crk

May 27, 2004



VINCENT MILLIN  
SUPERVISORY PATENT EXAMINER  
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